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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/774,268

02/06/2004

Alicia Roso

Serie 6101

8673

7590

09/05/2006

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EXAMINER

GEORGE, KONATA M

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/774,268	Applicant(s) ROSO ET AL.	
	Examiner Konata M. George	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-40 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/6/04; 6/1/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 12-40 are pending in this application.

Drawings

1. The drawing(s) filed under 37 CFR 1.184 or 1.152 are accepted by the examiner.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on February 6, 2004 and June 1, 2004 was noted and the submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

Nature of Invention

3. It is understood by the examiner from reading the specification that a "self-invertible inverse latex" is a composition comprising an oil phase, an aqueous phase, at least one water-in-oil emulsifier, at least one oil-in-water emulsifier and a branched or crosslinked polyelectrolyte (spec. page 3, lines 9-26). From this understanding of the "self-invertible inverse latex" the following rejections are being made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the examiner how much is "essentially free"? Is there a numerical value for "essentially free"? Please clarify.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 12-24 and 26-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 6, 10-16, 22 and 23 of U.S. Patent No. 6,197,287. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the patent are directed towards a composition comprising a "self-invertible inverse latex" as

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defined above (see Nature of Invention). The difference between the two lies in that the instant application requires an additional component (powder) whereas; the composition of the patent does not. The composition of the patent is not limited to what is claimed as the language "comprising" is used. One of ordinary skill in the art would be motivated to incorporate a powder into the composition for the purposes of providing texture to the final product i.e. soap, which may be used as a skin exfoliate.

6. Claims 12-24 and 26-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 15, 18, 20 and 22-24 of U.S. Patent No. 6,673,861. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the patent are directed towards a composition comprising a "self-invertible inverse latex" as defined above (see Nature of Invention). The difference between the two lies in that the instant application requires an additional component (powder) whereas; the composition of the patent does not. The composition of the patent is not limited to what is claimed as the language "comprising" is used. One of ordinary skill in the art would be motivated to incorporate a powder into the composition for the purposes of providing texture to the final product i.e. soap, which may be used as a skin exfoliate.

7. Claims 12-24 and 26-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 15, 18, 20 and 22-24 of U.S. Patent No. 7,033,600. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because both the instant application and the patent are directed towards a composition comprising a "self-invertible inverse latex" as defined above (see Nature of Invention). The difference between the two lies in that the instant application requires an additional component (powder) whereas; the composition of the patent does not. The composition of the patent is not limited to what is claimed as the language "comprising" is used. One of ordinary skill in the art would be motivated to incorporate a powder into the composition for the purposes of providing texture to the final product i.e. soap, which may be used as a skin exfoliate.

8. Claims 12-24, 26-40 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 29-31 and 33-35 of copending Application No. 09/888,441. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed towards a composition comprising a "self-invertible inverse latex" as defined above (see Nature of Invention). The difference between the two lies in that the instant application requires an additional component (powder) whereas; the composition of '441 does not. The composition of '441 is not limited to what is claimed as the language "comprising" is used. One of ordinary skill in the art would be motivated to incorporate a powder into the composition for the purposes of providing texture to the final product i.e. soap, which may be used as a skin exfoliate.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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9. Claims 12-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 19-21, 27-41, 44, 47 and 49 of copending Application No. 10/459,082. Although the conflicting claims are not identical, they are not patentably distinct from each other because both copending applications are directed towards a composition comprising a "self-invertible inverse latex" as defined above (see Nature of Invention). The difference between the two lies in that the instant application requires an additional component (powder) whereas; the composition of '082 does not. The composition of '082 is not limited to what is claimed as the language "comprising" is used. One of ordinary skill in the art would be motivated to incorporate a powder into the composition for the purposes of providing texture to the final product i.e. paint to formulate texturized paint.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 12-14, 16, 17, 26-35, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mikolajewicz et al. (EP 0 503 853).

Applicants claim a texturizing composition comprising at least one self-invertible inverse latex and at least one powder.

Determination of the scope and content of the prior art

(MPEP §2141.01)

Mikolajewicz et al. teach topical compositions containing an oil phase, an aqueous (water) phase, O/W and W/O emulsifiers and anionic copolymers (page 3, lines 6-32). Example 4, page 8 disclose a composition comprising an inverse emulsion a powder component (Micropearl M 100, polymethylmethacrylate powder) together with additional excipients.

Ascertainment of the difference between the prior art and the claims

(MPEP §2141.02)

The prior art does not teach the concentrations of the oil phase, emulsifiers, or polyelectrolyte as claimed. It is also not taught the particle size of the powder or concentration of the powder.

Finding of prima facie obviousness

Rational and Motivation (MPEP §2142-2143)

With respect to the claimed concentrations of the oil phase, emulsifiers, or polyelectrolyte, absent a clear showing of criticality, the determination of particular concentrations is within the skill of the ordinary worker as part of the process of normal optimization to achieve the desired results of the claimed composition. Although the particle size and concentration of the powder are not disclosed, the determination of the particle size would have been obvious to one of ordinary skill in formulating how much texture the composition will have and the increased concentration of the powder in the composition would lend to the final appearance i.e. increase powder would yield a composition having more of a powdery feel whereas decrease powder would yield a composition having more of an emulsion feel.

Conclusion

11. Claims 12-40 are rejected.

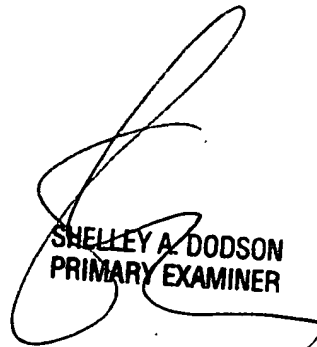
Telephone Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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